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Siemens Corporation  
Intellectual Property Department  
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EXAMINER
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FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/528,693

Applicant(s)

WRIGHT ET AL.

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination ("RCE") under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality of the previous Office action (in Paper No. 14) has been withdrawn pursuant to 37 C.F.R. §1.114. Applicants' submission filed on September 23, 2003 (Paper No. 15) has been entered.

### ***Acknowledgments***

2. In accordance with the RCE noted above, the after final amendment filed September 23, 2003 (Paper No. 15) has been entered. Accordingly, claims 1-6 remain pending.

### ***Specification***

3. The substitute specification filed with the amendment in Paper No. 15 has been entered.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1), MPEP § 608.01(o), and MPEP §2181. Correction of the following is required: the "means for automatically interfacing" as recited in claim 6.

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***Claim Rejections - 35 USC § 112 2<sup>nd</sup> Paragraph***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. The claims are replete with errors.

a. In claim 1, the phrase “said predetermined product, said predetermined product” in line 5 does not make grammatical sense. “A claim must be read in accordance with the precepts of English grammar.” *In re Hyatt*, 708 F.2d 712, 714, 218 USPQ 195, 197 (Fed. Cir. 1983).

b. In claim 2, it remains unclear whether the Applicants are claiming the subcombination of a product information system or the combination of a product information system *and* the product since Applicants recite: “said indicator is specific to each product . . . .”

c. Also in claim 6, it is unclear what structural elements make up the “automatically interfacing to the Internet to access said web page based on said indicator.” “Structure disclosed in the specification is ‘corresponding’ structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.” *Medtronic, Inc., v. Advanced Cardiovascular Systems, Inc.* 248 F.3d 1303, 1311, 58 USPQ2d 1607, 1614 (Fed. Cir. 2001)(citations and quotations omitted). In other words, “[f]or claim clauses containing functional limitations in ‘means for’ terms pursuant to §112 ¶ 6, the claimed function and its supporting structure in the specification *must be* presented with sufficient particularity to satisfy

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the requirements of §112 ¶ 2. [Emphasis added.]” *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1367, 59 USPQ2d 1745, 1747 (Fed. Cir. 2001) (citations omitted).<sup>1</sup> In this case, Applicants have again failed to clearly link or associate the ‘means for’ phrase to some corresponding structure found in their specification. Appropriate correction is still required.

### *Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

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<sup>1</sup> “Failure to describe adequately the necessary structure, material, or acts corresponding to a means-plus-function limitation in the written description means that the drafter has failed to comply with Section 112, Para. 2.” *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1380, 53 USPQ2d 1225, 1229 (Fed. Cir. 1999) citing *In re Dossel*, 115 F.3d 942, 945, 42 USPQ2d 1881, 1884 (Fed. Cir. 1997)). As a quid pro quo for the convenience of employing §112, paragraph 6, Applicant has a clear duty to clearly link or associate structure to the claimed function. *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1360, 54 USPQ2d 1308, 1313 (Fed. Cir. 2000) citing *B. Braun Med., Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997).

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8. Claims 1-6, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Cragun et. al. (U.S. 5,804,803) ("Cragun '803"). Cragun '803 discloses an indicator (code 117, translation program 110, and URL output; the bar code is a machine readable form of the URL) associated with a product and embedded in a memory (in the magnetic encoded media or radio frequency tag); a web page (document 174) indicated by the indicator (via the URL); the indicator directs the web page to product information (inherent) where the information is provided to the user (via display screen 114); wherein the indicator is specific to each product (tangible object 115) such that a plurality of indicators are needed to find out information about a plurality of products; the indicator (at least the bar code part) is disposed on the label which is on the object (tangible object 115 in Figure 1A); memory (106); means for automatically interfacing with the Internet to access the web page (120 and 121); and the memory is a micro-chip (inherent in radio frequency tag).

9. Claims 1-6, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 102(e) as being anticipated by Reber et. al. (U.S. 5,940,595) ("Reber '595"). Reber '595 discloses a product information apparatus (80) comprising an indicator (the machine readable data within the RF device which is within 80) associated with a predetermined product with the indicator embedded in a memory (the information/indicator is within the memory which is in turn, within the RF tag); the product is coupleable to a PLC (the RF device contains a PLC since the RF device is an "active" RF device and the RF device is coupleable to the product); the PLC is coupleable to a network (the Internet); the indicator is indicative of a network webpage (inherent

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in URLs) where product information is provided; the network webpage having an online product help window (inherent in webpages); the indicator is specific to each product (there is only one indicator per product); and the memory is a micro-chip (inherent in an "active" radio frequency tag).

*Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-6, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Cragun '803 in view of Ohanian et. al. (U.S. 6,109,526) ("Ohanian").<sup>2</sup> It is the Examiner principle position that the claims are anticipated because of the inherent features (*i.e.* the old and well known structure and features of RF tags). However if not inherent, Ohanian directly teaches the use of RF tags in replace of bar codes because, inter alia, bar codes may be obscured.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cragun '803 as taught by Ohanian to include RF tags in replace

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<sup>2</sup> See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

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of bar codes. Such a modification would have helped get the data more quickly if the bar codes became obscured.

12. Claims 1-6, as understood by the Examiner, are also rejected under 35 U.S.C. 103(a) as being unpatentable over Hudz et. al. (U.S. 5,978,773)("Hudz") in view of Ohanian. Hudz directly or inherently discloses all the claimed features except it uses bar codes instead of memory. Ohanian directly teaches the use of RF tags in replace of bar codes because, inter alia, bar codes may be obscured.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hudz as taught by Ohanian to include RF tags in replace of bar codes. Such a modification would have helped get the data more quickly if the bar codes became obscured.

13. Functional recitations using the word "for" (e.g. "for providing said product information" as recited in claim 1) have been given little patentable weight<sup>3</sup> because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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<sup>3</sup> See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.).



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14. For due process purposes, the Examiner again confirms that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner again notes the following factual findings as first expounded in the previous Office Actions.<sup>4</sup> First, the Examiner has again carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements.<sup>5</sup> Third, after receiving express notice of the Examiner's position that lexicography is *not* invoked,<sup>6</sup> Applicants first response did not point out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicants did not argue lexicography *was* invoked). Forth and to be sure of Applicants' intent, the Examiner also notes that Applicants have declined the Examiner's express invitation<sup>7</sup> to be their own

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<sup>4</sup>See the Examiner's Initial Office Action mailed January 6, 2003, Paper No. 9, Paragraph No. 18; and the First Final Office Action mailed July 30, 2003, Paper No. 14, Paragraph No. 18.

<sup>5</sup> "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, at the very least, point to a term or terms in the claim with which to draw in those statements." *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

<sup>6</sup> See the Examiner's Initial Office Action mailed January 6, 2003, Paper No. 9, Paragraph No. 18

<sup>7</sup> *Id.*

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lexicographer.<sup>8</sup> Finally, after receiving express notice of the preceding factual findings and conclusions, Applicants' latest response again fails to point out the supposed errors in the Examiner's position regarding *lexicography invocation* in accordance with 37 C.F.R. §1.111(b). Moreover, Applicants' latest response—while fully considered by the Examiner—does not change the Examiner's conclusion that Applicants have decided not to be their own lexicographer. Therefore (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning for claim terminology is confirmed. Accordingly, the claims continue to be interpreted with their "broadest reasonable interpretation," *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997),<sup>9</sup> and the Examiner continues to rely heavily and extensively on this interpretation.<sup>10</sup>

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<sup>8</sup> The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicants intend their claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicants was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21<sup>st</sup> Century Strategic Plan, February 3, 2003 available at [www.uspto.gov/web/offices/com/strat21/index.htm](http://www.uspto.gov/web/offices/com/strat21/index.htm) (last accessed December 6, 2003).

<sup>9</sup> See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) ("In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification."); MPEP §§ 2111 and 2111.01; and *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

<sup>10</sup> See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . . [Emphasis added.]"

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15. The Examiner maintains his interpretations of claim terms as stated in the previous Office Actions. Also as previously noted, to the extent that the Examiner's interpretations are in dispute with Applicants' interpretations, the Examiner hereby adopts the additional definitions—under the broadest reasonable interpretation standard—in all his claim interpretations.<sup>11</sup> Moreover, while the following list is provided in accordance with *In re Morris*, the definitions are a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language.<sup>12</sup> Finally, the following list is not intended to be exhaustive in any way:

a. **Web site** “A group of related HTML documents and associated files, scripts, and databases that is served up by an HTTP server on the World Wide Web. The HTML documents in a Web site generally cover one or more related topics and are interconnected through hyperlinks. Most Web sites have a home page as their starting point, which frequently functions as a table of contents for the site. Many large organizations, such as corporations, will have one or more HTTP servers dedicated to a single Web site. However, an HTTP server can also serve several small Web sites, such as those owned by individuals. Users need a Web browser and an Internet connection to access a Web site.” Computer Dictionary, 3rd Edition, Microsoft Press,

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<sup>11</sup> While most definitions are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

<sup>12</sup> See e.g. *Brookhill-Wilk 1 LLC v. Intuitive Surgical Inc.*, 334 F.3d 1294, 1300, 67 USPQ2d 1132, 1137 (Fed. Cir. 2003) (abstract dictionary definitions are not alone determinative; “resort must always be made to the surrounding text of the claims in question”).

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Redmond, WA, 1997.<sup>13</sup> *HTTP Sever* “1. Server software that uses HTTP to serve up HTML documents and any associated files and scripts when requested by a client, such as a Web browser. The connection between client and server is usually broken after the requested document or file has been served. HTTP servers are used on Web and Intranet sites. *Also called* Web Sever . . . . 2. Any machine on which an HTTP server program is running.” *Id.*

***35 U.S.C. 112 6<sup>th</sup> Paragraph***

**Means Phrase #1**

***Invocation***

16. It is the Examiner’s position that in claim 6, the phrase “means for automatically interfacing to an internet to access said web page based on said indicator” (“Means Phrase #1”) is an attempt by Applicants to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. If Applicants disagree, the Examiner respectfully requests Applicants to either amend the claim to remove all instances of “means for” from the claim, or to explicitly state on the record (and supply arguments in support thereof) why 35 U.S.C. 112 6<sup>th</sup> paragraph should not be invoked.

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<sup>13</sup> Based upon Applicants’ disclosure, the art of record, and the knowledge of one of ordinary skill in this art, the Examiner again finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See *e.g. Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used *Microsoft Press Computer Dictionary* (3d ed.) as “a technical dictionary” used to define the term “flag.” See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and MPEP §2173.05(a) titled “New Terminology”.

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**Invocation Step 1:**

a. First, in accordance with the MPEP §2181, the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6<sup>th</sup>* (“Guidelines”)<sup>14</sup>, and *Al-Site Corp. v. VSI International Inc.*, 174 F.3d 1308, 1318, 50 USPQ2d 1161, 1166 (Fed. Cir. 1999),<sup>15</sup> Applicant’s use of “means for” in claim 1 creates a rebuttable presumption that tends to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. If the word “means” appears in a claim element in combination with a function, it is presumed to be a means-plus-function element in which §112 6<sup>th</sup> paragraph applies. *Id.* Since “means for” is recited in Means Phrase #1, this step is clearly met.

**Invocation - Step 2:**

b. Second, in accordance with MPEP §2181, the Guidelines, and *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376, 58 USPQ2d 1801, 1806 (Fed. Cir. 2001), it is the Examiner’s position that Applicants recite a corresponding function to the means—“automatically interfacing to an internet to access said web page based on said indicator.”

The Examiner notes that when determining the function recited “[u]nless something in the written description suggests that the patentee intended the unambiguous language to be construed in a manner inconsistent with its ordinary meaning, we are bound by that language.” *Telemac*

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<sup>14</sup> Federal Register Vol 65, No 120, June 21, 2000.

<sup>15</sup> See also *Sage Prods., Inc. v. Devon Industry, Inc.*, 126 F.3d 1420, 1427, 44 USPQ2d 1103, 1109 (Fed. Cir. 1997); *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583, 39 USPQ2d 1783, 1785 (Fed. Cir. 1996).

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*Cellular Corp. v. Topp Telecom Inc.*, 58 USPQ2d 1545, 1550 (Fed. Cir. 2001). In this case, because nothing suggests otherwise, the function as found in the Means Phrase #1 will have its ordinary meaning.

**Invocation - Step 3:**

c. Third, in accordance with MPEP §2181, the Guidelines, and *Personalized Media Communications, LLC v. International Trade Commission*, 161 F.3d 696, 704, 48 USPQ2d 1880, 1887 (Fed. Cir. 1998), the means-plus-function clause must not recite sufficient definite structure for performing that function.

In our case, Means Phrase #1 does not recite the structural elements which perform the function. In determining whether the presumption of invocation is rebutted, “the focus remains on whether the claim ... recites sufficiently definite structure.” *Id.* Furthermore, sufficient structure does not require an exhaustive recitation—only structure to perform entirely the claimed function. *Rodime PLC v. Seagate Technology Inc.*, 174 F.3d 1294, 1304, 50 USPQ2d 1429, 1436 (Fed. Cir. 1999). Clearly the “automatically interfacing to the internet” can not be entirely performed by the little if any recited structure in the claim.

Because of the above, it is the Examiner’s position that Means Phrase #1 invokes 35 U.S.C. 112 6<sup>th</sup> paragraph.

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*Corresponding Structure, Material, or Acts*

17. In accordance with MPEP §2181, the Guidelines (section “II”) and *Medtronic*, 248 F.3d at 1311, 58 USPQ2d at 1614, “The next step is to determine the corresponding structure described in the specification and equivalents thereof. Structure disclosed in the specification is ‘corresponding’ structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.” *Id.*

a. In our case and as noted above, the corresponding structure is not clearly linked in the written description with the required specificity. Therefore, a 35 U.S.C. 112 2<sup>nd</sup> paragraph rejection results. For example, the corresponding structure could be a modem, a DSL network, or some other network connection.

18. Furthermore, it is the Examiner’s position that the means-plus-function limitation in claim 6 is not the *only* point of novelty. First, the pending system claims are combination claims made of old and possibly new elements. See *e.g. Clearstream Wastewater Sys. v. Hydro-Action, Inc.*, 206 F.3d 1440, 1446, 54 USPQ2d 1185, 1190 (Fed. Cir. 2000)(noting that there is “a general rule that combination claims can consist of combinations of old elements as well as new elements”). Second, in combination claims, there is no essential element or “gist” of the invention. *Cooper Cameron Corp. v. Kvaerner Oilfield Products Inc.*, 62 USPQ2d 1846, 1850 (Fed. Cir. 2002) (noting that “there is no legally recognizable or protected ‘essential’ element, ‘gist’ or ‘heart’ of the invention in a combination patent.”). In light of these facts and after further review of the specification, the Examiner finds that the means-plus-function limitation is not solely

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determinative of patentability. In other words, the Examiner finds that the means-plus-function limitation in the claim 6 is not the *only* point of novelty. The Examiner relies on this presumption.

***Response to Arguments***

19. Applicants' arguments filed September 23, 2003 (Paper No. 15) have been fully considered but they are not persuasive.

20. Regarding Applicants' arguments involving 35 USC § 112 2<sup>nd</sup> paragraph, they are not persuasive. First, the Examiner simply asks, is the product part of the claim?

21. Second, the Applicants have not specified what is the corresponding structure for the means plus function limitation. Applicants again state "Claim 6 was rejected under 35 USC § 112 ¶ 6." This is simply false. The Examiner again notes that the heading under which the 35 USC § 112 2<sup>nd</sup> paragraph rejections were given: "Claim Rejections - 35 USC § 112 2<sup>nd</sup> Paragraph." If Applicants' are having difficulty understanding the application of 35 USC § 112 6<sup>th</sup> paragraph, Applicants should contact the Examiner at the telephone number listed below. The Examiner again suggests Applicants read MPEP §2181-2185 and *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994).



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***Anticipation Rejections***

22. Applicants argue Cragun does not disclose an indicator associated with a predetermined product, said indicator containing a memory.” The Examiner respectfully disagrees. First the “Object” in Figure 1A is a product. Second the RF transmitter *must* have a memory.

23. Applicants also argue “Cragun does not disclose a ‘said predetermined product coupleable to a [PLC].’” Again, the Examiner respectfully disagrees. Virtually all PLCs are coupleable to a product. See also Figure 1A.

***Obviousness Rejections***

24. Applicants arguments are acknowledged. Although Applicants state broad sections of the claim are not found in the references, this statement is simply false. Applicant makes no attempt to traverse the findings noted in the obviousness rejection. Again, the URL in Cragun ‘803 is “the indicator” Applicants state that the references do not disclose.

***Dictionaries***

25. Applicants also argue that “The Office Actions provide no documentary evidence linking specific proffered definitions to the “ordinary meaning of claim language as understood by one of ordinary skill in the art.”” Applicants’ Remarks, Paper No. 15, pages 8 and 9.

26. First, Applicants have again confused “legal conclusions” with “factual findings.” Affidavits are used for facts—not law. As far as using dictionaries to ascertain the ordinary

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meaning, this question of law is “well settled.” See *Inverness Medical v. Warner Lambert Co.*, 309 F.3d 1373, 1378, 64 USPQ2d 1933, 1936 (Fed. Cir. 2002) (“It is well settled that dictionary definitions provide evidence of a claim term’s ordinary meaning. Potentially relevant dictionaries include dictionaries of the English language (providing general definitions and usages) and technical dictionaries, encyclopedias, and treatises (providing specialized meanings as used in particular fields of art).”)(citations and quotations omitted); *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1818 (Fed. Cir. 2002) (“For such ordinary meaning, we turn to the dictionary definition of the term.”)(citations and quotations omitted); and *e.g. Intellectual Property Development Inc. v. UA-Columbia Cablevision of Westchester Inc.*, 336 F.3d 1308, 1315, 67 USPQ2d 1385, 1390 (Fed. Cir. 2003) (noting that “the district court did not err in looking to dictionary definitions before consulting the written description or the prosecution history to determine the meaning of the term ‘high frequency.’”). In conclusion, it clearly well settled that “dictionary definitions may establish a claim term’s ordinary meaning.” *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002).

27. Because of Applicants’ claim amendments, the rejections from the previous Office Actions not found in this Office Action are withdrawn.

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***Conclusion***

28. The prior art made of record considered pertinent to Applicants' disclosure includes the following: Perkowski (U.S. 6,625,581 B1); Harding et. al. (U.S. 6,573,906 B1); Jammes et. al. (U.S. 6,484,149 B1); Walden et. al. (U.S. 6,421,065 B1); and Habib et. al. (U.S. 5,825,356).

29. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8<sup>th</sup> Edition, Rev 1, February 2003. All remaining MPEP citations are from MPEP 8<sup>th</sup> Edition, August 2001.

30. It is the Examiner's factual determination that all limitations in claims 1-6 have been considered and are either disclosed or inherent in the references as discussed above. Furthermore, the inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) ("Preponderance of the evidence is the standard that must be met by the PTO in making rejections." (citations and quotations omitted)). The preceding discussion in this paragraph regarding the standard for claim rejections applies to all examined claims currently pending.

31. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has provided Applicant with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. If Applicant disagrees with *any* factual determination or

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legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,<sup>16</sup> the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) *in his next response*. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. To respond to this Office Action by facsimile, fax to (703) 872-9306.



Andrew J. Fischer  
Patent Examiner

AJF  
December 6, 2003

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<sup>16</sup> E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.